

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
Irah H. Donner :  
Serial No. : Group Art Unit:  
Filed: 30 March 2001 : Examiner:  
For: COMPUTER ASSITED METHOD OF PERFORMING INTELLECTUAL PROPERTY  
(IP) AUDIT OPTIONALLY OVER NETWORK ARCHITECHTURE

PRELIMINARY AMENDMENT

Honorable Commissioner of  
Patents and Trademarks  
Washington, D. C. 20231

Sir:

This Preliminary Amendment is being filed concurrently with the above-referenced application. The following amendments and remarks are respectfully submitted.

IN THE TITLE

Please change the title from

“Intellectual Property Audit System” to

--COMPUTER ASSISTED METHOD OF PERFORMING INTELLECTUAL PROPERTY  
(IP) AUDIT OPTIONALLY OVER NETWORK ARCHITECTURE--

IN THE SPECIFICATION

Please amend the specification as follows:

After Related Applications, please change

"This application is a continuation-in-part application of U.S. Application Serial number 08/161,816 filed on December 6, 1993, incorporated herein by reference." to

--This is a continuation application of US Application No. 09/518,681 filed March 3, 2000 which in turn claims is continuation-in-part application of U.S. Application Serial number 08/161,816 filed on December 6, 1993, now Patent No. 5,999,907, each of which is incorporated herein by reference.--

IN THE CLAIMS

Please cancel claims 1 through 14 without prejudice or disclaimer.

Please add new claims 15 through 41. (Clean claims attached to preliminary amendment)

IN THE ABSTRACT

Please replace the abstract with the new abstract attached.

REMARKS

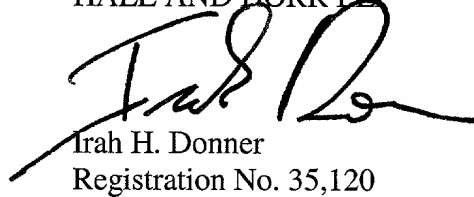
This Preliminary Amendment is submitted to improve the form of the specification and claims as originally filed. The Related Applications Section has been corrected to more appropriately claim priority and continuation status. It is respectfully requested that this Preliminary Amendment be favorably examined and entered in the above-referenced application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,  
HALE AND DORR LLP



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Date: 4/23/01

What is claimed:

15. A computer assisted process for determining an estimated value of an intellectual property portfolio, the process comprising the steps of:

(a) storing first objectively determinable characteristics of representative intellectual property portfolios and objectively determinable values corresponding to each of the representative intellectual property portfolios, the first objectively determinable characteristics and the objectively determinable values forming a baseline against which to assess the estimated value of the intellectual property portfolio;

(b) analyzing the intellectual property portfolio to determine second objectively determinable characteristics of the intellectual property portfolio to be estimated;

(c) deriving first information representing the second objectively determinable characteristics of the intellectual property portfolio to be estimated responsive to said analyzing step (b);

(d) retrieving second information representing the first objectively determinable characteristics and the objectively determinable values of the representative intellectual property portfolios; and

(e) comparing the first information received from said deriving step (c) to the second information received from said retrieving step (d) producing an estimated value of the intellectual property portfolio when the first information of the intellectual property portfolio is statistically similar to the second information of one of the representative intellectual property portfolios.

16. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein the intellectual property portfolio comprises at least one of patented, trademarked, trade secreted and copyrighted intellectual property.

17. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein at least one of a patent database, a trademark database, a copyright database, a technical literature database, a legal reporter database, a current events database and an intellectual property status database are utilized to determine the estimated value of the intellectual property portfolio.

18. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15,

wherein the intellectual property portfolio comprises a patent portfolio including patents, and  
wherein the first objectively determinable characteristics includes patent information derived from the patents in the patent portfolio comprising at least one of the following: number of claims, length of independent claims, number and dates of references cited, number of classes searched, legal status of the patents, number of years until each of the patents expire, group which examined each of the patents, domestic priority, and foreign priority.

19. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 18, wherein the patent information further includes frequency with which the patents have been cited as references for other patents.

20. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, further comprising the step of weighing each of the first and second objectively determinable characteristics according to predetermined weighing factors producing weighed first and second objectively determinable characteristics, and

comparing the weighed first and second objectively determinable characteristics to determine the statistical similarity between the weighed first and second objectively determinable characteristics.

21. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15,

wherein the intellectual property portfolio includes issued patents, and at least one of trademarks and copyrights, and

wherein the first objectively determinable characteristics are derived by analyzing the issued patents, and the at least one of trademarks, trade secrets and copyrights.

22. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein the estimated value of the intellectual property portfolio is derived substantially independent of accounting valuation techniques including cost, market and income approaches.

23. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein the first information of the intellectual property portfolio is determined to be statistically similar to the second information of one of the representative intellectual property portfolios utilizing at least one of a curve fitting technique and a standard deviation technique.

24. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15,  
wherein the first objectively determinable characteristics include first valuation indicators,  
wherein the first valuation indicators are assigned an importance factor based upon predetermined criteria, and  
wherein the first valuation indicators are compared to the second objectively determinable characteristics and the estimated value of the intellectual property portfolio is determined responsive to the importance factor of each of the valuation indicators.

25. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein the objectively determinable values of the representative intellectual property portfolios include objectively determinable monetary values.

26. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 25, wherein the objectively determinable monetary values of the representative intellectual property portfolios are determined by at least one of prior adjudication, prior license values, prior purchase values and an accountant evaluation based upon generally acceptable accounting procedures (GAAP) of the representative intellectual property portfolios.

27. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 15, wherein the first objectively determinable characteristics include at least one of prior adjudication values, prior license values, and prior purchase values.

28. A computer assisted process for determining an estimated value of an intellectual property portfolio, the process comprising the steps of:

- (a) analyzing the intellectual property portfolio;
- (b) deriving first information responsive to said analyzing step (a) based upon the intellectual property portfolio;
- (c) retrieving empirical data relating to known intellectual property portfolios; and
- (d) comparing the first information derived in said deriving step (b) to the empirical data retrieved from said retrieving step (c) producing an estimated intellectual property worth indicator indicating the worth of the intellectual property portfolio.

29. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein the intellectual property portfolio comprises at least one of patented, trademarked, trade secreted and copyrighted intellectual property.

30. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein at least one of a patent database, a trademark database, a copyright database, a legal reporter database, a technical literature database, a current events database and an intellectual property status database are utilized to determine the estimated intellectual property worth indicator of the intellectual property portfolio.

31. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28,  
wherein the intellectual property portfolio comprises a patent portfolio including patents, and  
wherein the first information includes patent information derived from the patents in the patent portfolio comprising at least one of the following: number of claims, length of independent claims, number and dates of references cited, number of classes searched, legal status of the patents, number of years until each of the patents expire, group which examined each of the patents, domestic priority, and foreign priority.

32. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 31, wherein the patent information further includes frequency with which the patents have been cited as references for other patents.

33. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, further comprising the step of weighing each of the first information and the empirical data according to predetermined weighing factors producing weighed first information and weighed empirical data respectively, and

said comparing step (d) further comprises the step of comparing the weighed first information and the weighed empirical data to determine similarity therebetween to determine the estimated intellectual property worth indicator.

34. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28,

wherein the intellectual property portfolio includes issued patents, and at least one of trademarks, trade secrets and copyrights, and

wherein the first information are derived by analyzing the issued patents, and the at least one of trademarks and copyrights.

35. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein the estimated intellectual property worth indicator of the intellectual property portfolio is derived substantially independent of accounting valuation techniques including cost, market and income approaches.

36. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein the first information of the intellectual property portfolio is determined to be statistically similar to the empirical data of the intellectual property portfolio utilizing at least one of a curve fitting technique and a standard deviation technique.

37. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28,

wherein the first information includes first valuation indicators,

wherein the first valuation indicators are assigned an importance factor based upon predetermined criteria, and

wherein the first valuation indicators are compared to the empirical data and the estimated intellectual property worth indicator of the intellectual property portfolio is determined responsive to the importance factor of the first valuation indicators.



38. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein the first information of the intellectual property portfolio includes an objectively determinable monetary value.

39. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 38, wherein the objectively determinable monetary value of the intellectual property portfolio is determined by at least one of prior adjudication, prior license values, prior purchase values and an accountant evaluation based upon generally acceptable accounting procedures (GAAP) of the intellectual property portfolio.

40. A computer assisted process for determining an estimated value of an intellectual property portfolio according to claim 28, wherein the first information includes at least one of prior adjudication values, prior license values, and prior purchase values.

41. A computer assisted process for determining an estimated value of an intellectual property portfolio, the process comprising the steps of:

- (a) analyzing the intellectual property portfolio stored in an intellectual property database;
- (b) deriving first information responsive to said analyzing step (a) based upon the intellectual property portfolio;
- (c) retrieving empirical data relating to known intellectual property portfolios; and
- (d) comparing the first information derived in said deriving step (b) to the empirical data retrieved from said retrieving step (c) producing an intellectual property worth indicator indicating the worth of the intellectual property portfolio,

wherein the intellectual property database includes at least one of a patent database, a trademark database, a technical literature database, a copyright database, a legal reporter database, a current events database and an intellectual property status database.

# **COMPUTER ASSISTED METHOD OF PERFORMING INTELLECTUAL PROPERTY (IP) AUDIT OPTIONALLY OVER NETWORK ARCHITECTURE**

## **ABSTRACT OF THE DISCLOSURE**

A computer assisted method of performing an intellectual property (IP) audit estimates a value of an intellectual property portfolio. The computer assisted method includes the steps of analyzing the IP portfolio, and deriving first information responsive to said analyzing step based upon the IP portfolio. The computer assisted method also includes the steps of retrieving empirical data relating to known IP portfolios, and comparing the first information to the empirical data producing an IP worth indicator indicating an estimated worth of the IP portfolio. The computer assisted method is optionally implementable over a network architecture.